

REMARKS:

Claims 1-35 are pending. Claims 1-35 are rejected. The first instance of claim 30 has been previously canceled; the second instance of claim 30 is currently pending.

Claim Amendments

Claims 1-2, 4, 7, 11-12, 15, 20, 23, 27-31 and 33-34 are amended with clarifying amendments. These amendments are supported throughout the specification, for example, page 4, lines 19-30 (“control means 30 is provided, in this example, by a suitably programmed processor” and “In other embodiments one or more processors and one or more memories may be used”). These are deemed to be non-substantive and relate to truncating preambles and removing certain “means” elements.

No new matter is added.

Entry of these amendments is respectfully requested.

Improper Finality of Office Action

The Applicants assert that the pending Office Action has prematurely been made final.

Consider MPEP § 706.07(a):

“Under present practice, second or **any subsequent actions on the merits** shall be final, **except** where the examiner introduces a **new ground of rejection** that is **neither necessitated by applicant's amendment** of the claims” (emphasis added).

The Examiner asserts “Applicant's amendments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**”. However, it is noted that the Examiner has rejected independent claim 33, as **originally presented**, using the new grounds of rejection. Clearly, this Office Action has improperly been made final.

The Applicants respectfully request the Examiner reconsider and withdraw the finality of the rejection.

Claim Rejection - 35 U.S.C. 103(a)

The Examiner has rejected claims 1-19 as being unpatentable under 35 U.S.C. 103(a) over

Lin et al. (U.S. Patent Pub. No. 2005/0096071), herein Lin, in view of Lielbriedis (U.S. Patent Pub. No. 2001/0051528), herein Lielbriedis. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1-19.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a *prima facie* case for obviousness. Thus, as interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.¹

Regarding claim 1, which recites:

“A method comprising:
in the terminal of a first party participating in a telephone call, storing, as a **consequence of the telephone call**, identifier data that identifies a second party participating in the telephone call;
using the stored identifier data to determine automatically a destination address for a data message; and
sending, during the telephone call, a data message with the automatically determined destination address” (emphasis added).

Lin discloses: “establishing an audio connection with a second device” and “sending a first data to the second device during the audio connection with the second device” and “specifically relates to the transferring of data over a voice channel” (see Abstract and paragraph [0001]). Clearly, the same channel is used for both the audio and the data communication.

Lin does not appear to be concerned with a method of mapping information stored as a consequence of one type of communication onto an address used for another type of

¹ *In Re Fine*, 5 U.S.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Agmen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

communication. It appears that the user is limited to a single type of communication.

As noted by the examiner, Lin fails to disclose “storing, as a consequence of the telephone call, identifier data that identifies a second party participating in the telephone call” and “using the stored identifier data to determine automatically a **destination address** for a data message” as in claim 1.

Lielbriedis discloses the use of an SMS message to notify a user at a mobile terminal that an email addressed to the user has arrived at a server. The user accesses “the stored e-mail by using the reply-function of the mobile communication station 210 for replying to the received SMS message”. The “originating address of the received SMS message will be used as the destination address of the responding SMS message” (see paragraph [0040]).

Lielbriedis appears to disclose a reply to an SMS and therefore fails to disclose “storing, **as a consequence of the telephone call**, identifier data that identifies a second party **participating in the telephone call**” and “using the stored identifier data to determine automatically a destination address for a data message” as in claim 1.

Lielbriedis does not appear to be concerned with a method of mapping information stored as a consequence of one type of communication onto an address used for another type of communication.

Additionally, Lielbriedis does not disclose or suggest “sending, **during the telephone call**, a data message with the automatically **determined destination address**” as in claim 1.

Neither Lin nor Lielbriedis, disclose or suggest “storing, **as a consequence of the telephone call**, identifier data that identifies a second party **participating in the telephone call**” and “using the stored identifier data to determine automatically a **destination address** for a data message” as in claim 1. Clearly, even if one were to combine Lin and Lielbriedis (which the Applicants do not assert there is a motivation or teaching to do), the combination of Lin and Lielbriedis, herein Lin-Lielbriedis, also would not disclose or suggest “storing, **as a consequence of the telephone call**, identifier data that identifies a second party **participating in the telephone call**” and “using the stored identifier data to determine automatically a **destination address** for a data message” as in claim 1.

Furthermore, it is unclear how one would combine Lin and Lielbriedis. Would the combination send the “SMS message” of Lielbriedis over “a voice channel during a telephone call” as in Lin? This would still not disclose or suggest claim 1.

For at least these reasons, claim 1 is in condition for allowance. As claim 12 recites similar language to that discussed above with reference to claim 1, claim 12 is likewise in condition for allowance. As claims 2-11 and 13-19 depend upon claims 1 and 12, they are likewise in condition for allowance. However, in order to fully address the Examiner’s rejections regarding dependent claims 2-11 and 13-19, the Applicants submit the comments below.

Regarding claims 7 and 8, the Examiner asserts that “Lielbriedis teaches storing the identifying information and being able to later retrieve the information for a response to the messages. (Para. 9)”.

Assuming arguendo that the Examiner is correct (which the Applicants do not assert), this does not disclose or suggest “automatically **interrogating a database** using the identifier data to obtain the destination address” as in claim 7 and associating “the identifier data with contact **addresses** of the second party” as in claim 8.

For at least this reason, claims 7 and 9 are in condition for allowance.

The Examiner has rejected claims 20-29 and 30-35 as being unpatentable under 35 U.S.C. 103(a) over Lin in view of Lielbriedis in further view of Hansmann et al. (U.S. Patent Pub. No. 2001/0016835), herein Hansmann. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 20-29 and 30-35.

These rejections are respectfully disagreed with, and are traversed below.

Regarding claim 20, which recites:

“A method comprising, in a terminal of a first party participating in a telephone call:

providing, while the telephone call is on-going, a user selectable option to transfer data to another party participating in the telephone call **via a new channel** that runs in parallel with a voice channel used for the telephone call,

without user specification of a destination address" (emphasis added).

As seen above, Lin "specifically relates to the transferring of data **over a voice channel**" and so fails to disclose "providing, while the telephone call is on-going, a user selectable option to transfer data to another party participating in the telephone call **via a new channel** that runs in parallel with a voice channel used for the telephone call, without user specification of a destination address" as in claim 20. Rather, the teaching in Lin appears to be in direct contradiction to "transfer data to another party participating in the telephone call **via a new channel**" as in claim 20.

Also, as seen above Lielbriedis discloses SMS communications rather than phone calls. It also discloses the use of the same channel for both communications. Clearly, Lielbriedis fails to disclose "providing, **while the telephone call is on-going**, a user selectable option to transfer data to another party participating in the telephone call **via a new channel that runs in parallel with a voice channel used for the telephone call**, without user specification of a destination address" as in claim 20.

Hansmann does not disclose how the parallel data channel is set up. It fails to disclose "providing, while the telephone call is on-going, a user selectable option to transfer data to another party participating in the telephone call via a new channel that runs in parallel with a voice channel used for the telephone call, **without user specification of a destination address**" as in claim 20.

Neither Lin, Lielbriedis nor Hansmann, disclose or suggest disclose "providing, while the telephone call is on-going, a user selectable option to transfer data to another party participating in the telephone call via a new channel that runs in parallel with a voice channel used for the telephone call, without user specification of a destination address" as in claim 20. Clearly, even if one were to combine Lin, Lielbriedis and Hansmann (which the Applicants do not assert there is a motivation or teaching to do), the combination of Lin, Lielbriedis and Hansmann, herein Lin-Lielbriedis-Hansmann, also would not disclose or suggest "providing, while the telephone call is on-going, a user selectable option to transfer data to another party participating in the telephone

call via a new channel that runs in parallel with a voice channel used for the telephone call, without user specification of a destination address” as in claim 20.

For at least these reasons, claim 20 is in condition for allowance. As claim 28 recites similar language to that discussed above with reference to claim 20, claim 28 is likewise in condition for allowance. As claims 21-27, 29-32 and 35 depend upon claims 20 and 28, they are likewise in condition for allowance.

Regarding claim 33, which recites:

“A method comprising:
in a terminal of a first party, storing, as a consequence of a communication between the first party and a second party, identifier data that identifies the second party;
using, subsequent to the communication between the first party and the second party, the stored identifier data to determine automatically a destination address for a data message; and
sending a data message with the automatically determined destination address” (emphasis added).

As seen above, Lin- Lielbriedis does not disclose or suggest “storing, **as a consequence of a communication** between the first party and a second party, identifier data that identifies the second party” and “using, subsequent to the communication between the first party and the second party, the stored identifier data to determine automatically a **destination address** for a data message” as in claim 33.

Hansmann discloses “method... for payment in a purchasing action performed by means of a cellular standard communication between a customer using said cellular standard communication device and a provider”. The “communication between said customer and said provider is performed via a voice channel” and “transmissions of an electronic bill from said provider to said customer, of a money transfer order from said customer to a payment provider and of a receipt of payment from said payment provider to said customer are performed via a service channel of the cellular standard network” (see Abstract).

Hansmann fails to disclose “storing, **as a consequence of a communication** between the first party and a second party, identifier data that identifies the second party” and “using, subsequent to the communication between the first party and the second party, the stored

identifier data to determine automatically a **destination address** for a data message” as in claim 33.

Hansmann does not appear to be concerned with a method of mapping information stored as a consequence of one type of communication onto an address used for another type of communication.

Neither Lin, Lielbriedis nor Hansmann, disclose or suggest disclose “storing, **as a consequence of a communication** between the first party and a second party, identifier data that identifies the second party” and “using, subsequent to the communication between the first party and the second party, the stored identifier data to determine automatically a **destination address** for a data message” as in claim 33. Clearly, Lin-Lielbriedis-Hansmann also would not disclose or suggest “storing, **as a consequence of a communication** between the first party and a second party, identifier data that identifies the second party” and “using, subsequent to the communication between the first party and the second party, the stored identifier data to determine automatically a **destination address** for a data message” as in claim 33.

For at least these reasons, claim 33 is in condition for allowance. As claim 34 recites similar language to that discussed above with reference to claim 33, claim 34 is likewise in condition for allowance.

In light of the discussion above, the Applicant respectfully asserts that a *prima facie* case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections to claims 1-29 and 31-35.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

S.N.: 10/725,274
Art Unit: 2617

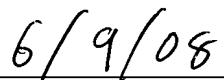
Respectfully submitted:



Ricardo Ochoa

Reg. No.: 61,545

Customer No.: 29,683



Date

HARRINGTON & SMITH, PC

4 Research Drive

Shelton, CT 06484-6212

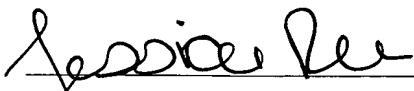
Telephone: (203) 925-9400

Facsimile: (203) 944-0245

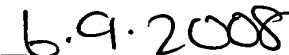
Email: ROchoa@HSpatent.com

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